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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q67950

Yosihidie MURAKAMI, et al.

Appln. No.: 10/028,914

Group Art Unit: 1771

Confirmation No.: 2679

Examiner: Victor s. Chang

Filed: December 28, 2001

For: SUBSTRATE FILM FOR ADHESIVE SHEET AND ADHESIVE SHEET USING THE
SAME

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Final Office Action dated October 3, 2003, Applicants respectfully request reconsideration in view of the remarks herein below, Terminal Disclaimer filed concurrently herewith and pages 800-20 to 800-21 from the Manual of Patent Examining Procedure (MPEP) discussing statutory double patenting under 35 U.S.C. § 101.

The claims under consideration are claims 1-9, 17 and 18.

In paragraph 4 of the Office, Claims 1, 2, and 4 through 7 are rejected under 35 U.S.C. § 101 as claiming the same invention as claims 4-7 of prior U.S. Patent 6,372,339. In particular, the Examiner submits that claim 1 of the present invention pertains to the same subject matter as claim 4 of the parent patent.

With reference to pages 800-20 to 800-21 from the MPEP, 35 U.S.C. § 101 prevents two patents from issuing on the same invention. "Same invention" means identical subject matter.

REQUEST FOR RECONSIDERATION
U.S. APPLN. NO. 10/028,914

The MPEP goes on to state that a reliable test for determining double patenting under 35 U.S.C. § 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. If there is an embodiment that falls within the scope of one claim, but not the other, then identical subject matter is not defined by both claims and statutory double patenting would not exist.

With the above in mind, comparison of claim 1 of the present application with claim 4 of the '339 patent can only lead to the conclusion that statutory double patenting under 35 U.S.C. § 101 does not exist with respect to those claims.

Claim 4 of the '339 patent depends upon its claim 1. The subject matter of claim 4 is a combination of claim 1 with claim 4. This subject matter states that the substrate film comprises an elastomer resin, inorganic fine particles (claim 1) plus a hydrophilic polymer (claim 4). On the hand, claim 1 of the present application states that the substrate film comprises an elastomer and a hydrophilic polymer. Thus, claim 1 of the present application does not literally require that the inorganic fine particles of claim 1 of the '339 patent be present. Therefore, the present application could be literally infringed by only the inclusion of the elastomer and the hydrophilic polymer while claim 4 of the parent patent could not be literally infringed by the presence of the those two elements without the presence of inorganic fine particles. Thus, there is an embodiment which literally falls within the scope of claim 1 of the present application and does not literally fall within the scope of claim 4 of the parent patent. As a result, statutory double patenting under 35 U.S.C. § 101 does not exist. The same conclusion would also be reached with respect to claims 5-7 of the parent '339 patent, since each of those claims depends upon

REQUEST FOR RECONSIDERATION
U.S. APPLN. NO. 10/028,914

claim 4. As a result, each of those claims, from infringement, requires the presence of the inorganic fine particles. Accordingly, the literal embodiment of claim 1 of the present application would not infringe claims 5-7 of the '339 patent. Again, statutory double patenting under 35 U.S.C. § 101 does not exist since the identical subject matter is not being claimed in any claim of the present application as in any claim of the '339 patent.

In the above discussion, Applicants consider the infringement issue only with respect to 35 U.S.C. § 101 and the literal language of the claims of the parent patent of the present application and do not intend any comments thereon to be relevant to a potential consideration of claim scope under the doctrine of equivalence.

In paragraph 5 of the Office Action, claims 3, 8, 9, 17 and 18 are rejected under the judicially created doctrine of obviousness-double patenting as being unpatentable over claims 3, 4, 10, 11 and 18-19 of the '339 patent. Although Applicants entirely disagree with the reasoning of the Examiner for the basis of the rejection in paragraph 5 of the Office Action, a Terminal Disclaimer is submitted herewith to obviate this rejection.

Applicants submit that all claims are now in condition for allowance. If any minor points remain prior to Notice of Allowance, the Examiner is respectfully requested to contact the undersigned at the below listed phone number.

REQUEST FOR RECONSIDERATION
U.S. APPLN. NO. 10/028,914

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

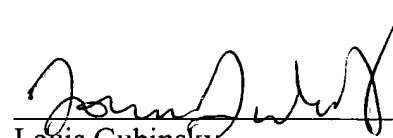
Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER


Louis Gubinsky
Registration No. 24,835

Date: January 30, 2004

addressed during original prosecution, it may be considered during reexamination.

II. REQUIREMENTS OF A DOUBLE PATENTING REJECTION (INCLUDING PROVISIONAL REJECTIONS)

When a double patenting rejection is appropriate, it must be based either on statutory grounds or nonstatutory grounds. The ground of rejection employed depends upon the relationship of the inventions being claimed. Generally, a double patenting rejection is not permitted where the claimed subject matter is presented in a divisional application as a result of a restriction requirement made in a parent application under 35 U.S.C. 121.

Where the claims of an application are substantively the same as those of a first patent, they are barred under 35 U.S.C. 101 - the statutory basis for a double patenting rejection. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor" Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957). Where the claims of an application are not the "same" as those of a first patent, but the grant of a patent with the claims in the application would unjustly extend the rights granted by the first patent, a double patenting rejection under nonstatutory grounds is proper.

In determining whether a proper basis exists to enter a double patenting rejection, the examiner must determine the following:

(A) Whether a double patenting rejection is prohibited by the third sentence of 35 U.S.C. 121 (see MPEP § 804.01; if such a prohibition applies, a double patenting rejection cannot be made);

(B) Whether a statutory basis exists; and

(C) Whether a nonstatutory basis exists.

Each determination must be made on the basis of all the facts in the application before the examiner. Charts I-A, I-B, II-A, II-B, III-A, and III-B illustrate the methodology of making such a determination.

Domination and double patenting should not be confused. They are two separate issues. One patent or application "dominates" a second patent or application when the first patent or application has a broad or generic claim which fully encompasses or reads on an invention defined in a narrower or more specific claim in another patent or application. Domination by itself, i.e., in the absence of statutory or nonstatutory double patenting grounds, cannot support a double patenting rejection. *In re Kaplan*, 789 F.2d 1574, 1577-78, 229 USPQ 678, 681 (Fed. Cir. 1986); and *In re Sarrett*, 327 F.2d 1005, 1014-15, 140 USPQ 474, 482 (CCPA 1964). However, the presence of domination does not preclude double patenting. See, e.g., *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

A. Statutory Double Patenting — 35 U.S.C. 101

In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? 35 U.S.C. 101 prevents two patents from issuing on the same invention. "Same invention" means identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. For example, the invention defined by a claim reciting a compound having a "halogen" substituent is not identical to or substantively the same as a claim reciting the same compound except having a "chlorine" substituent in place of the halogen because "halogen" is broader than "chlorine." On the other hand, claims may be differently worded and still define the same invention. Thus, a claim reciting a widget having a length of "36 inches" defines the same invention as a claim reciting the same widget having a length of "3 feet."

If it is determined that the same invention is being claimed twice, 35 U.S.C. 101 precludes the grant of the second patent regardless of the presence or absence of a terminal disclaimer. *Id.*

Form paragraphs 8.30 and 8.31 (between an issued patent and one or more applications) or 8.32 (provisional rejections) may be used to make statutory double patenting rejections.

¶ 8.30 35 U.S.C. 101, Statutory Basis for Double Patenting "Heading" Only

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process... may obtain a patent therefor..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Examiner Note:

The above form paragraph must be used as a heading for all subsequent double patenting rejections of the statutory (same invention) type using either of form paragraphs 8.31 or 8.32.

¶ 8.31 Rejection, 35 U.S.C. 101, Double Patenting

Claim [1] rejected under 35 U.S.C. 101 as claiming the same invention as that of claim [2] of prior U.S. Patent No. [3]. This is a double patenting rejection.

Examiner Note:

1. This paragraph must be preceded by form paragraph 8.30 and is used only for double patenting rejections of the same invention claimed in an earlier patent; that is, the "scope" of the inventions claimed is identical.
2. If the conflicting claims are in another copending application, do not use this paragraph. A provisional double patenting rejection should be made using paragraph 8.32.
3. Do not use this paragraph for non-statutory-type double patenting rejections. If non-statutory type, use appropriate form paragraphs 8.33 to 8.39.
4. This paragraph may be used where the conflicting patent and the pending application are:
 - (a) by the same inventive entity, or
 - (b) by a different inventive entity and are commonly assigned even though there is no common inventor, or
 - (c) not commonly assigned but have at least one common inventor.
5. In bracket 3, insert the number of the conflicting patent.

6. If the patent is to a different inventive entity and is commonly assigned with the application, paragraph 8.27 should additionally be used to require the assignee to name the first inventor.

7. If evidence is of record to indicate that the patent is prior art under either 35 U.S.C. 102(f) or (g), a rejection should also be made using paragraphs 7.15 and/or 7.19 in addition to this double patenting rejection.

8. If the patent is to a different inventive entity from the application and the effective U.S. filing date of the patent antedates the effective filing date of the application, a rejection under 35 U.S.C. 102(e) should additionally be made using form paragraph 7.15.02.

¶ 8.32 Provisional Rejection, 35 U.S.C. 101, Double Patenting

Claim [1] provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim [2] of copending Application No. [3]. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Examiner Note:

1. This paragraph must be preceded by form paragraph 8.30 and is used only for double patenting rejections of the same invention claimed in another copending application; that is, the scope of the claimed inventions is identical.
2. If the conflicting claims are from an issued patent, do not use this paragraph. See paragraph 8.31.
3. Do not use this paragraph for non-statutory-type double patenting rejections. See paragraphs 8.33 to 8.39.
4. This paragraph may be used where the conflicting claims are in a copending application that is:
 - (a) by the same inventive entity, or
 - (b) by a different inventive entity and is commonly assigned even though there is no common inventor, or
 - (c) not commonly assigned but has at least one common inventor.
5. Paragraph 8.28 may be used in place of or along with this paragraph to resolve any remaining issues relating to priority under 35 U.S.C. 102(f) or (g).
6. In bracket 3, insert the number of the conflicting application.
7. A provisional double patenting rejection should also be made in the conflicting application.
8. If the copending application is by a different inventive entity and is commonly assigned, paragraph 8.27 should additionally be used to require the assignee to name the first inventor.
9. If evidence is also of record to show that either application is prior art unto the other under 35 U.S.C. 102(f) or (g), a rejection should also be made in the other application using paragraphs 7.15 and/or 7.19 in addition to this provisional double patenting rejection.
10. If the applications do not have the same inventive entity and effective U.S. filing date, a provisional 102(e) rejection should additionally be made in the later-filed application using paragraph 7.15.01.

If the "same invention" is not being claimed twice, an analysis must be made to determine whether a non-statutory basis for double patenting exists.